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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

Applicants : Michael D. Ellis et al.
Application No. : 09/332,244 Confirmation No. : 2681
Filed : June 11, 1999
For : CLIENT-SERVER BASED INTERACTIVE
TELEVISION PROGRAM GUIDE SYSTEM WITH
REMOTE SERVER RECORDING
Group Art Unit : 2623
Examiner : Hunter B. Lonsberry

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Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

New York, New York 10020
September 27, 2007

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

In response to the Final Office Action mailed June 27, 2007, applicants request a panel review of the pending rejection prior to proceeding with the full appeals process.

Applicants enclose with these remarks the requisite Notice of Appeal.

The Final Office Action is the third Office Action in this case. Applicants have amended independent claims 250, 571, 645, 650, 732 and 810 twice during prosecution, because the Examiner indicated each time that the amendments would put the claims in condition for allowance. Despite this, the Examiner has finally rejected the claims based on a combination of three references. The combination is clearly not proper and the rejection is therefore without basis. Accordingly, applicants hereby seek a panel review of the rejection.

The Claims. Independent claims 250, 571, 645, 650, 732 and 810 recite a remote media server configured to store and play back programs on-demand for a number of

users and a headend which provides broadcast programming. In addition, an Internet service system, which is configured to provide program guide data using an Internet based approach, is used to provide requests to the remote media server (see claims 250 and 732) or implement an online interactive television program guide (see claims 571, 645, 650 and 810).

The Final Office Action. In the Final Office Action mailed June 27, 2007, the Examiner repeats rejections made in the preceding non-final Office Action mailed December 19, 2006, without addressing the arguments raised by applicants in their Reply to Office Action mailed March 14, 2007. Prior to submitting that Reply to Office Action, applicants' representative conducted a telephonic interview with the Examiner, in which applicants' representative pointed out that Aristedes cannot be combined with Lawler and that Aristedes teaches away from applicants' claimed invention. The Examiner indicated that applicants' representative raised a valid argument and requested that the argument be put in the Reply. The Examiner also mentioned that an amendment to the claims would help further prosecution of this case. In their Reply, applicants incorporated the Examiner's suggestions by amending the claims as requested and by presenting the arguments made during the telephonic interview. In response, the Examiner ignored the amendments and arguments made by applicants, relying upon the same combination of Aristedes and Lawler in addition to a new third reference to support a final rejection under 35 U.S.C. § 103(a). In a telephonic interview conducted on August 9, 2007, the Examiner would not admit that he made an error yet again in combining Aristedes and Lawler to arrive at applicants' claimed invention.

The Proposed Combination. Aristides is generally directed to "alleviat[ing] the bottleneck associated with handling many requests during peak activity times" (Aristides, col. 3, lines 7-9). Aristides is concerned that the infrastructure connecting the headend to the users has a limited capacity and that capacity is strained when the users communicate upstream to the headend (see Aristides, col. 7, lines 34-39). According to Aristides, this creates a "bottleneck" problem. Aristides solves this bottleneck problem by reducing the number of upstream requests (see, e.g., Aristides, col. 7, lines 40-45).

Aristedes fails to disclose "an EPG that [1] generates a record request in response to the user indicating a desire to record a program on-demand with a remote media

server, [2] storing the requested program remotely and [3] an Internet service system" (see Office Action, June 27, 2007, p. 4). The Office Action relies on Lawler to fill deficiencies 1 and 2.*

In particular, the Examiner analogizes applicants' "record requests" with Lawler's "record tags."** Lawler's record tags "can be though [sic] of as a request to the system to record a program. Each record tag is associated with a program to be recorded and the viewer station or user that set the record tag" (Lawler, col. 12, lines 58-60). Lawler's headend monitors all of the record tags that are sent by various users and activates recording equipment at the appropriate time(s) (see Lawler, col. 13, lines 11-27). Record tags are sent to the headend regardless of whether the program will be recorded at the viewer's end or at the headend (see id.).

Aristides is focused on reducing the number of upstream requests received by the headend (see Aristides, col. 2, lines 52-55). One skilled in the art would not modify Aristides to send record tags upstream -- even when the program is being recorded locally. Lawler does exactly that (see, e.g., Lawler, col. 13, lines 11-27; claim 1 ("storing the record tag at the head end"); claim 9 ("...for communicating the record tag to the head end...")). By sending unnecessary requests upstream, Lawler exacerbates the very upstream bottleneck problem that Aristides sought to alleviate. Therefore, one of ordinary skill in the art would *never* be motivated by such a disclosure to combine Lawler with Aristides. Moreover, even assuming one having ordinary skill in the art was motivated to make the Examiner's proposed combination, such a combination would render Aristides unsatisfactory for Aristides' primary purpose (i.e., minimizing the number of user requests sent upstream). See Aristides, col. 2, lines 52-55. If anything, one having ordinary skill in the art would combine Aristides with

* The Office Action relied on Schein to fill deficiency 3. Applicants hereby submit that Schein also cannot be combined with Aristides or Lawler. In addition, Applicants submit that the combination of Aristides, Lawler and Schein fails to show or suggest all of the claim elements. Applicants reserve the right to further explain these submissions if necessary.

** Applicants hereby submit that the "record requests" recited by Applicants' claims are different than Lawler's "record tags" and reserve the right to explain further if necessary.

Lawler to arrive at a system that used local recording to minimize requests to the headend, *not* applicants' claimed invention.

In sum, Aristides teaches away from applicants' invention and its combination with Lawler because Aristides is directed to minimizing a user's interaction with the headend. At least because (i) the teachings of Aristides and Lawler do not suggest the desirability of applicants' invention, (ii) the teachings of Aristides and Lawler conflict, and (iii) the combination of Aristides with Lawler would render Aristides unsuitable for its intended purpose, the Examiner made a clear error in combining the teachings of Aristides and Lawler and has failed to make a *prima facie* case of obviousness.

Conclusion

Applicants have shown numerous deficiencies in the three-reference obviousness rejection of the Final Office Action. A *prima facie* case of obviousness has not been made. Examiner's reliance on the proposed combination is clear error. The rejection of all claims should be withdrawn and the case allowed.

Dated: September 27, 2007

Respectfully submitted,



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